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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,442	03/15/2002	Bernard Danner	1999CH020	1768

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CLARIANT CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
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EXAMINER

EINSMANN, MARGARET V

ART UNIT PAPER NUMBER

1751

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/088,442	Applicant(s) DANNER ET AL.	
	Examiner Margaret Einsmann	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☒ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other:  |

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7, 9-26 are indefinite for the following reasons. The preamble to claim 1 describes a method of treating of textile pieces goods with textile treatment agent (T). First, the term (T) is indefinite since its metes and bounds cannot be defined. In addition, the steps of the process do not refer to (T). Instead, P<sub>A</sub> is applied to the textile piece goods. The steps do not include any reference to the treatment agent (T), so one is left to wonder about the relationship of (T) to P<sub>A</sub>. Is T also applied to the textile piece goods? Are T and P<sub>A</sub> applied together? Sequentially? Is P<sub>A</sub> part of a composition comprising (T)? Is P<sub>A</sub> a subset of T, or is applied in combination with (T)? Also, what are the conditions which "would otherwise in the textile substrate favor the formation of transport folds and or the occurrence of friction?"

In claim 6 the (F) and (G) terms are indefinite since their metes and bounds cannot be determined. Isn't a thickening agent a flow control agent? Define each by a Markush group would be helpful.

In claim 7 (Z) is indefinite. What is the meaning of the term "formulation additive?" Since W already contains F and/or G, Z should also state that at least one additive in addition to those already claimed is included.

The claims are rambling and narrative in form. For example, claim 10 could be worded, "The method of claim 1 wherein (T) is a dye or optical brightener and the textile piece goods are made from synthetic polyamide microfibers, optionally blended with other fibers of comparable fineness.

Claim 14 does not further limit claim 1.

Claim 21 does not further limit claim 4.

Claim 22 does not further limit claim 5.

Claim 23 does not further limit claim 7

Claim 24 does not further limit claim 13.

Regarding composition claims 11-13, 16-20, 25 and 26, all of the components must be defined. Claim 3 is a process claim. Accordingly claim 11 is improperly dependent on claim 3 since a claimed composition cannot further limit a process.

Accordingly P<sub>A</sub> must be defined in claim 11,

W must be defined in claim 12;

W', P<sub>A</sub>, F, G, X, Y and Z must be defined in claim 13, 16 and 19:

P<sub>A</sub>, A<sub>1</sub> and A<sub>2</sub> must be defined in claim 17;

P<sub>A</sub>, B<sub>1</sub> and A<sub>1</sub> must be defined in claim 18;

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G must be defined in claim 20. All of the components must be defined in claims 21-26.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Applicant is advised that should claims 1,4,5,7 and 13 be found allowable, claims 14 and 21-24 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-13, 16-20, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Imperial Chemical Industries Limited , GB 1,108,811.

Condensation products of a dicarboxylic acid with a mixture of a diaminopolyalkyleneoxy and an aliphatic, cycloaliphatic or aromatic diamine and aqueous compositions thereof are disclosed for use in treating textile piece goods, which are the claimed compositions comprising  $P_A$ . See page 1 lines 13 et seq. Claim 1 of the patent discloses the lubricant as claimed in claim 11. Page 3 lines 49-62 disclose the limitation of claims 17-18. The following paragraph on page 3 , lines 63 et seq. teaches their solubility or dispersibility in aqueous media The examples disclose aqueous compositions containing additives as claimed. The addition of thickeners, starch or hydroxyalkyl cellulose is disclosed on page 4 lines 126,127. Regarding the claims to a process of making the claimed condensation products and compositions, the examples disclose the condensation products being mixed with water and various additives.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 703-308-3826. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

August 29, 2003



Margaret Einsmann  
Primary Examiner  
Art Unit 1751